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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,176	09/30/2003	John R. Allen	ALLEN/0002	2639
24945	7590	09/02/2004		
STREETS & STEELE 13831 NORTHWEST FREEWAY SUITE 355 HOUSTON, TX 77040			EXAMINER BRINSON, PATRICK F	
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			3752	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/675,176	Applicant(s) ALLEN, JOHN R.	
	Examiner Patrick F. Brinson	Art Unit 3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/12/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-29, drawn to an apparatus and method for plugging a tubular bore, classified in class 138, subclass 89.
 - II. Claim 30, drawn to a tool, classified in class 81, subclass unknown.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, wherein the invention of Group II does not require expandable sealing plugs to seal a tubular bore as is required by the invention of Group I. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Applicant's attorney, **Mr. Frank J. Campigatto** on Wednesday, August 25, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-29. Affirmation of this

election must be made by applicant in replying to this Office action. Claim 30 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter recited in claims 5 and 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 9, 11, 13, 15, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,474,216 to **Noe**.

The patent to **Noe** discloses an apparatus for plugging a tubular bore, fig. 3, including a shaft member (66), one or more cylindrical seals (80, 36a) wherein the shaft member passes axially through the cylindrical seals. One or more cylindrical sleeves (74, 76, 82, 78) are slidably disposed around the shaft member and adjacent to the one or more cylindrical seals. A flange (70) attached at the distal end of the shaft member, wherein the flange retains the cylindrical sleeves and seals on the shaft member. A pulling mechanism is disposed at a proximal end of the shaft member, as recited in claim 1. The pulling mechanism includes nut (6) disposed on a threaded outer circumference of the proximal end of the shaft member which is rotated causing the hollow

shaft to slide axially in a proximal direction within the cylindrical sleeves and seals, as recited in claims 13 and 15. Col. 3, lines 10-12, discloses that the cylindrical sleeves, the body and flange are all formed of a metal, as recited in claim 11.

6. Claims 1, 2, 6-11, 13-15, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,760,868 to **Saxon**.

The patent to **Saxon** discloses an apparatus for plugging a tubular bore, including a shaft member (14), one or more cylindrical seals (20, 32) wherein the shaft member passes axially through the cylindrical seals. One or more cylindrical sleeves (22, 24, 26, 28) are slidably disposed around the shaft member and adjacent to the one or more cylindrical seals. A flange (8) attached at the distal end of the shaft member, wherein the flange retains the cylindrical sleeves and seals on the shaft member. A pulling mechanism is disposed at a proximal end of the shaft member, as recited in claim 1. The pulling mechanism includes nut (18) and washer (34) disposed on a threaded outer circumference of the proximal end of the shaft member which is rotated causing the hollow shaft to slide axially in a proximal direction within the cylindrical sleeves and seals, as recited in claims 13-15. The seal members are disclosed as being formed of neoprene rubber, as recited in claim 8. The

cylindrical sleeves and flange are formed of metals such as brass, titanium or stainless steel, as recited in claim 10.

7. Claims 1, 3, 4, 24, 25 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,602,500 to **Kelly**.

The patent to **Kelly** discloses an apparatus for plugging a tubular bore, including a hollow shaft member, cylindrical seal (100) wherein the shaft member passes axially through the cylindrical seal. One or more cylindrical sleeves (96, 104) are slidably disposed around the shaft member and adjacent to the one or more cylindrical seals. A flange (90) attached at the distal end of the shaft member, wherein the flange retains the cylindrical sleeves and seals on the shaft member. A pulling mechanism is disposed at a proximal end of the shaft member, as recited in claim 1. The apparatus includes a valve, bleeder cap (116) being threadedly secured within the hollow shaft, as recited in claims 3, 4, and 27-29.

8. Claims 1 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,797,431 to **Adams**.

The patent to **Adams** discloses an apparatus for plugging a tubular bore, including a shaft member (22), cylindrical seal (62) wherein the shaft member passes axially through the cylindrical seal. Cylindrical sleeve (28) is slidably

disposed around the shaft member and adjacent to the one or more cylindrical seals. A flange (20) attached at the distal end of the shaft member, wherein the flange retains the cylindrical sleeves and seals on the shaft member. A pulling mechanism, including nut (26) is disposed at a proximal end of the shaft member, as recited in claim 1. The device includes a compressible sealant holder, spring (58), adjacent to the cylindrical sleeve, as recited in claims 16-18.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of US 5,065,981 to **Vario**.

The patent to **Kelly** discloses the recited structure, as discussed in preceding paragraph #, but does not disclose the valve as having a spring-loaded seal.

The patent to **Vario** discloses a water line test cap having a pneumatic valve (28) that has a spring-loaded seal, including spring (48) and valves (52 and 54).

It is disclosed that when bleeding is desired all that is needed is to push plunger

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(50), thereby unseating valves (52 and 54), permitting air, and some water to escape the bore through valve openings (38 and 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute for the bleeder cap of **Kelly** a bleeder valve including a spring loaded seal as suggested by **Vario** in order to provide an alternate means of bleeding fluid and air from the tubular member that is sealed, wherein they are shown to be equivalents in the art.

10. Claims 12 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Saxon**.

The patent to **Saxon** does not disclose the material of which the flange, sleeves and shaft member are made to be different, nor does it disclose the diameter between the sleeve and seals. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the sleeve, flange and/or the shaft of different materials because Applicant has not disclosed that forming them of different materials provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the same materials. Therefore, it would have been an obvious matter of design choice to modify the materials of **Saxon** to obtain the invention as specified in claim 12.

Likewise, it would be obvious to modify the sleeves and seals such that the difference

in diameter between the bore and the sleeves/seals is between 0.02 inches and 0.2 inches, wherein there is no particular advantage, since **Saxon** discloses a plug member that is of sufficient diameter to be inserted within the tubular bore and which may be expanded through the pulling mechanism to seal the pipe.

Allowable Subject Matter

11. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Dominguez, Kipp, Leslie, Finocchiaro, Morawiecki, Ljungberg, Guild, O'Donnell et al., Thaxton, Berube et al., Steblina, Turnwald, and McAlpine et al. are pertinent to Applicant's invention in disclosing bore plug devices.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Patrick F. Brinson** whose telephone number is (703) 308-0111. The examiner can normally be reached on M-F 7:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Michael Y. Mar** can be reached on (703) 308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick F. Brinson
Primary Examiner
Art Unit 3752

P. F. Brinson
August 27, 2004